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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,277	08/31/2000	E. Antonio Chiocca	0609.4880002/JAG/KRM	4747

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EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
1632	18

DATE MAILED: 05/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/653,277	CHIOCCA ET AL.
	Examiner Joseph Woitach	Art Unit 1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-36 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-36 are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

Art Unit: 1632

**DETAILED ACTION**

This application filed August 31, 2000, claims benefit to provisional application 60/151,621, filed August 31, 1999.

Claims 1-36 are pending and currently under examination.

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

*7W 6/13/02* I. Claims 1-<sup>3</sup>4, 13-33 and 36, drawn to a herpes viral mutant comprising a deletion in both copies of the  $\gamma$ 34.5 gene and insertion of a  $\gamma$ 34.5 gene under the transcriptional control of a cell-specific or tumor specific promoter and a method of use of said herpes virus, classified in class 514, subclass 44; class 435, subclass 325.

*7W 6/13/02* II. Claims 5, 6, 34 and 35, drawn to a herpes viral mutant comprising a deletion in both copies of the  $\gamma$ 34.5 gene and insertion of a  $\gamma$ 34.5 gene under the transcriptional control of a cell-specific or tumor specific promoter further characterized by at least one additional deletion or inactivating mutation, classified in class 514, subclass 44; class 435, subclass 325.

III. Claims 7-12, drawn to a herpes viral mutant comprising a deletion in both copies of the  $\gamma$ 34.5 gene and insertion of a  $\gamma$ 34.5 gene under the transcriptional control of a cell-specific or tumor specific promoter further characterized by at least one

Art Unit: 1632

additional deletion or inactivating mutation and further comprising a transgene,  
classified in class 435, subclass 325.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case each group encompasses a different and unique recombinant herpes virus. The herpes virus encompassed by group I could potentially be used as an intermediate to generate the virus encompassed by groups II and III, however the herpes virus encompassed by groups II and III comprise further modifications, and the resulting recombinant virus have characteristics which would be unique to each virus. Further, as set forth in method claims of group I, the virus encompassed by groups II and III are not required to practice the method set forth in claims 17-33. The differences between the inventions are further underscored by their independent search status. In the instant case, the different herpes virus characterized by different deletions and/or insertion of other heterologous transgene sequences would require additional and different searches.

Because these inventions are distinct for the reasons given above have acquired a separate status in the art as shown by their different classification and divergent subject matter restriction for examination purposes as indicated is proper.

Art Unit: 1632

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach, whose telephone number is (703) 305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist Pauline Farrier whose telephone number is (703)305-3550.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

Joseph T. Woitach

*Joe Woitach*  
AU1632